

**REMARKS**

**STATUS OF CLAIMS**

Claims 1-3, 5-6, 9-14, 16-17, 20-24, 26-27, 30-34, 36-37, and 40-41 are pending. Claims 1, 5, 11, 12, 16, 21, 22, 26, 31, 32, 36 and 41 have been amended. Support for these amendments can be found in the originally filed specification, for example on page 8 under heading “D. Dihydrocarbyl Hydrogen Phosphite,” the Examples on pages 12-14, and original claims 8, 19, 29, and 39. Claims 1, 12, and 32 have been amended to further define an additive composition comprising an anti-foam agent, wherein the antifoam agent comprises about 0.01 to about 1.0 wt.% of the power transmitting fluid. Support for this amendment can be found, for example, on page 8 under heading “C. Anti-Foam Agent” and cancelled claims 4, 15, and 35. Claim 22 had been amended to further define a power transmitting fluid additive composition comprising an anti-foam agent, wherein the anti-foam agent comprises about 0.04 to about 4.0 wt.% of the additive composition. Support for this amendment can be found, for example, on page 8 under heading “C. Anti-Foam Agent” and cancelled claim 25. Claims 4, 7, 8, 15, 18, 19, 25, 28, 29, 35, 38 and 39 have been cancelled. No new matter has been added.

**REJECTION UNDER § 112**

The Examiner has rejected claims 1-21, 31 and 41 under 35 U.S.C. § 112, second paragraph. Specifically, the Examiner argued that the scope of claims 1 and 12 is confusing because each recite “major amount of a base oil” and “minor amount of an additive composition” and it is not clear what is meant by “major” or “minor.” See page 2 of Office Action. Applicants respectfully submit that one of ordinary skill in the art would not find such claim limitations confusing. One skilled in the art would know that “a major amount of a base oil” would be an amount greater than or equal to 50% and “a minor amount of an additive composition” would be an amount less than 50%.

The Examiner also argued that claims 11, 21, 31, and 41 each recite “belt, chain, or disk-type continuously variable transmission” and the scope of the claims is confusing in light of the use of the word “type”. The Examiner further argues that the word “type” extends the scope of the claims so as to render them indefinite because it is

unclear what "type" is intended to convey. See *id.* Applicants respectfully disagree with the Examiner's rejection but, in the interest of advancing prosecution, have amended the claims by deleting "type."

Applicants respectfully submit that the presently claimed invention particularly points out and distinctly claims the subject matter which Applicants regard as their invention, in accordance with 35 U.S.C. § 112. Applicants respectfully request reconsideration and withdrawal of the rejection.

## **REJECTIONS UNDER § 102**

### **1. U.S. Patent No. 6,528,458**

The Examiner has rejected claims 1-6, 9-17, 20-27, 30-37, and 40-41 under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,528,458 to Tagliamonte et al. ("Tagliamonte"). Applicants note that the Examiner has not rejected claims 8, 19, 29 and 39. Independent claims 1, 12, 22, and 32 have been amended to incorporate the subject matter of nonrejected claims 8, 19, 28 and 39, respectively. Therefore, Tagliamonte does not teach the present invention. Applicants respectfully request reconsideration and withdrawal of the rejection.

### **2. U.S. Patent No. 4,231,757**

The Examiner has rejected claims 1-6, 9-17, 20-27, 30-37, and 40-41 as being anticipated by U.S. Patent 4,231,757 to Davis ("Davis") in view of the evidence given in U.S. Patent No. 6,660,695 to Watts ("Watts"). Applicants note that the Examiner has not rejected claims 8, 19, 28 and 29, the subject matters of which have been incorporated into independent claims 1, 12, 22, and 32, respectively. Therefore, the presently claimed invention possesses novelty over Davis. Applicants respectfully request reconsideration and withdrawal of the rejection.

3. European Patent No. 0113199

The Examiner has rejected claims 1, 5-12, 16-22, 26-32, and 36-41 as being anticipated by European Patent No. 0113199 to Cleveland et al. ("Cleveland"). Applicants note that the Examiner has not rejected claims 4, 15, 25, and 35, wherein the anti-foam agent comprises about 0.01 to about 1.0 wt.% of the power transmitting fluid. Independent claims 1, 12, 22, and 32 have been amended to incorporate the subject matters of claims 4, 15, 25, and 35, respectively. Therefore, the presently claimed invention possesses novelty over the reference. Applicants respectfully request reconsideration and withdrawal of the rejection.

4. U.S. Patent Application No. 2004/0129603

The Examiner has rejected claims 1-6, 9-17, 20-22, 27, 30-37, and 40-41 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application No. 2004/0129603 to Fyfe et al. ("Fyfe") taken in view of the evidence given in Watts. Applicants note that the Examiner has not rejected claims 8, 19, 29 and 39, which recite a dioleyl hydrogen phosphite. Independent claims 1, 12, 22, and 32 have been amended to incorporate the subject matter of claims 8, 19, 28 and 39, respectively. Therefore, Fyfe does not teach the present invention. Applicants respectfully request reconsideration and withdrawal of the rejection.

5. U.S. Patent No. 5,064,546

The Examiner has rejected claims 1-22 and 27-41 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,064,546 to Dasai ("Dasai") taken in view of the evidence given in Watts. The Examiner has argued that because Dasai teaches power transmitting fluid identical to that presently claimed including comprising additive composition identical to that presently claimed, the power transmitting fluid would inherently possess enhanced wear protection and enhanced anti-shudder durability. See pages 7-8 of Office Action. Applicants respectfully disagree for at least the following reasons.

In order to anticipate a claim, a reference must contain all elements of the claim. See *Hybritech v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). Further, a single source must disclose all of the claimed elements “arranged as in the claim.” See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Dasai teaches a lubricating oil composition comprising a friction modifier, such as phosphoric acid esters. See Abstract and col. 3, line 40. While Dasai teaches that a dioleyl hydrogen phosphite can be used, it does not utilize dioleyl hydrogen phosphite in any formulations with the other claimed components. Instead, the reference teaches an amine salt of oleyl hydrogen phosphite. See Examples 1 and 7, Table at cols. 7-8. Dasai does not teach a lubricating composition comprising a dioleyl hydrogen phosphite “arranged as in the claim.” Therefore, Dasai does not anticipate the presently claimed invention. For at least this reason, the presently claimed invention possesses novelty over the reference. Applicants respectfully request reconsideration and withdrawal of the rejection.

6. U.S. Patent Application No. 2005/0014656

The Examiner has rejected claims 1-3, 5-6, 9-14, 16-17, 20-23, 25-27, 30-34, 36-37, and 40-41 under 35. U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2005/0014656 to Sumiejeski et. al. (“Sumiejeski”) taken in view of the evidence given in Watts. Applicants note that the Examiner has not rejected claims 8, 19, 29 and 39, which recite a dioleyl hydrogen phosphite. Independent claims 1, 12, 22, and 32 have been amended to incorporate the subject matter of claims 8, 19, 28 and 39, respectively. Therefore, Sumiejeski does not teach the present invention. Applicants respectfully request reconsideration and withdrawal of the rejection.

7. European Patent No. 0646639

The Examiner has rejected claims 1-6, 9-17, 20-22, 27, 30-37, and 40-41 under 35 U.S.C. § 102(b) as being anticipated by European Patent No. 0646639 to Bigelow et al. (“Bigelow”) taken in view of the evidence given in Watts. Applicants note that the

Examiner has not rejected claims 8, 19, 29 and 39, which recite a dioleyl hydrogen phosphite. Independent claims 1, 12, 22, and 32 have been amended to incorporate the subject matter of claims 8, 19, 28 and 39, respectively. Therefore, Bigelow does not teach the present invention. Applicants respectfully request reconsideration and withdrawal of the rejection.

**REJECTIONS UNDER § 103(a)**

A. The Examiner has rejected claims 7-8, 18-19, 28-29, and 38-39 under 35 U.S.C. § 103(a) as being obvious over (a) Tagliamonte, (b) Davis in view of Tagliamonte, (c) Sumiejski in view of Dasai, and (d) Fyfe in view of U.S. Patent No. 6,884,855 to Nelson. These rejected claims have been cancelled rendering the rejections moot. Applicants respectfully request reconsideration and withdrawal of the rejections.

B. The Examiner has also rejected claims 23-26 as being obvious over Dasai or Fyfe. Claims 23-26 depend from independent claim 22 and are patentable for the same reasons as claim 22. In particular, and as discussed above, Dasai does not teach or suggest a power transmitting fluid additive composition comprising a dioleyl hydrogen phosphite, as presently claimed.

Moreover, for at least the reasons discussed above, Fyfe does not teach or suggest a power transmitting fluid additive composition comprising a dioleyl hydrogen phosphite, as presently claimed. For at least the foregoing reasons, Applicants respectfully submit that the presently claimed invention is not obvious in view of the cited references.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

**FEES**

The undersigned believes that there are no fees associated with this filing. However, if the calculations are incorrect, the Commissioner is hereby authorized to charge any deficiencies in fees or credit any overpayment associated with this communication to Deposit Account No. 05-1372. Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 05-1372.

Respectfully submitted,



Leah Robinson  
Leah Robinson, Reg. No. 44,990

330 South Fourth Street  
Richmond, VA 23219  
Phone: 804-788-5498  
FAX: 804-788-5519  
E-Mail: [Leah.Robinson@NewMarket.com](mailto:Leah.Robinson@NewMarket.com)

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